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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,996	12/10/2001	Stephen Carter	010079	3525

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QUALCOMM, INC
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EXAMINER	
FOX, BRYAN J	

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,996	CARTER, STEPHEN	
	Examiner	Art Unit	
	Bryan J. Fox	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,11-18 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,11-18 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Salihi (US005077791).

Regarding **claim 11**, Salihi discloses a system where each subscriber unit is capable of communicating in both a coded and an uncoded mode (see column 2, lines 20-41), which reads on the claimed, "in a wireless handset capable of operating in clear and secure modes." The system continually monitors communication during a call to determine whether the operation mode has been inadvertently or deliberately changed, and, if so, inhibits transmissions and presents an error message to the user, then a call request may be transmitted in the current operation mode (see column 5, line 60 – column 6, line 5 and figure 4), which reads on the claimed, "method of transitioning from secure mode to clear mode during a call, the method comprising: sending at least one message based on a request from a user wishing to transmission from a secure mode to a clear mode; confirming transition to the clear mode as received in response to the received message; and receiving at least one message authorizing a clear call request."

Regarding **claim 21**, Salihi discloses a system where each subscriber unit is capable of communicating in both a coded and an uncoded mode (see column 2, lines 20-41), which reads on the claimed, "in a wireless handset capable of operating in clear and secure modes." The system continually monitors communication during a call to determine whether the operation mode has been inadvertently or deliberately changed, and, if so, inhibits transmissions and presents an error message to the user, then a call request may be transmitted in the current operation mode (see column 5, line 60 – column 6, line 5 and figure 4), which reads on the claimed, "method of transitioning from secure mode to clear mode during a call, the method comprising: means for sending at least one message based on a request from a user wishing to transition from a secure mode to a clear mode; means for confirming transition to the clear mode as received in response to the received message; and means for receiving at least one message authorizing a clear call request."

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5, 12-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al (US006151677A) in view of Mannisto (US005805084A).

Regarding **claim 1**, Walter et al discloses a wireless telephone system for security where a keypad 152 includes a switch or other means, such as a pushbutton, for allowing the user to activate a secure transmission mode (see column 5, lines 34-

37). Walter et al fails to expressly disclose that the pushbutton must be pressed for a certain amount of time.

In a similar field of endeavor, Mannisto discloses a system where in order to set a keyboard lock, a user depresses and holds the key for a given delay period. If the button is not pressed for a certain amount of time, the phone does not enter the keyboard lock state (see column 2, line 62 – column 3, line 3). Further, if the phone is in the auto-locked state, only the unlock sequence will register in the phone once it is locked (see column 3, lines 35-45), satisfying the condition of "unless the handset is currently in either secure-only mode or auto secure mode."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61).

Regarding **claim 2**, the combination of Walter et al and Mannisto discloses a system where a PIN is used to unlock the security features (see Walter et al column 4, lines 50-52 and column 7, lines 6-10 and figure 3).

Regarding **claim 3**, the combination of Walter et al fails to disclose the predetermined amount of time is about two seconds.

In a similar field of endeavor, Mannisto discloses a system where a suitable delay for the key to be pressed and held down for is roughly 0.5-2 seconds (see Mannisto column 3, line 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61).

Regarding **claim 5**, the combination of Walter et al and Mannisto discloses that after the phone is powered on, the user unlocks it by entering a PIN (see Walter et al column 7, lines 6-10 and figure 3), which reads on the claimed "the step of entering a PIN number is entered each time the handset is activated".

Regarding **claim 12**, Walter et al discloses a wireless telephone system for security where a keypad 152, which reads on the claimed "user-interface capable of being depressed", includes a switch or other means, such as a pushbutton, for allowing the user to activate a secure transmission mode (see column 5, lines 34-37). Walter et al fails to expressly disclose that the pushbutton must be pressed for a certain amount of time.

In a similar field of endeavor, Mannisto discloses a system where in order to set a keyboard lock, a user depresses and holds the key for a given delay period. If the button is not pressed for a certain amount of time, the phone does not enter the keyboard lock state (see column 2, line 62 – column 3, line 3). This system must include the circuit for detecting the amount of time a key is depressed for as claimed. Further, if the phone is in the auto-locked state, only the unlock sequence will register in

the phone once it is locked (see column 3, lines 35-45), satisfying the condition of "unless the handset is currently in either secure-only mode or auto secure mode."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61).

Regarding **claim 13**, Walter et al discloses a wireless telephone system for security where a keypad 152 includes a switch or other means, such as a pushbutton, for allowing the user to activate a secure transmission mode (see column 5, lines 34-37). Walter et al fails to expressly disclose that the pushbutton must be pressed for a certain amount of time.

In a similar field of endeavor, Mannisto discloses a system where in order to set a keyboard lock, a user depresses and holds the key for a given delay period. If the button is not pressed for a certain amount of time, the phone does not enter the keyboard lock state (see column 2, line 62 – column 3, line 3). Further, if the phone is in the auto-locked state, only the unlock sequence will register in the phone once it is locked (see column 3, lines 35-45), satisfying the condition of "unless the handset is currently in either secure-only mode or auto secure mode."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Walter et al with Mannisto so that the holding of the key sets the secure mode in order to avoid the need for a separate key which takes up space in the

keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61).

Regarding **claim 14**, the combination of Walter et al and Mannisto discloses a system where a PIN is used to unlock the security features (see Walter et al column 4, lines 50-52 and column 7, lines 6-10 and figure 3), which reads on the claimed "means for entering a personal identification number (PIN) to register as a secure user".

Regarding **claim 15**, Walter et al fails to expressly disclose the predetermined amount of time is about 2 seconds.

In a similar field of endeavor, Mannisto discloses a system where a suitable delay for the key to be pressed and held down for is roughly 0.5-2 seconds (see Mannisto column 3, line 3).

Regarding **claim 17**, the combination of Walter et al and Mannisto discloses that after the phone is powered on, the user unlocks it by entering a PIN (see Walter et al column 7, lines 6-10 and figure 3), which reads on the claimed "the step of entering a PIN number is entered each time the handset is activated".

Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al in view of Mannisto as applied to claim 1 above, and further in view of Alanara et al (US005845205A).

Regarding **claims 4 and 16**, the combination of Walter et al and Mannisto fails to expressly disclose that the key pressed down is the send/talk key.

In a similar field of endeavor, Alanara et al discloses a phone system where a function is assigned to holding down the "send" key (see column 3, lines 50-61).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto so that the send key is held down in order to provide a more intuitive interface.

Claims 6, 7, 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al and Mannisto as applied to claim 2 above, and further in view of Harris et al (US006442406B1).

Regarding **claims 6 and 18**, the combination of Walter et al and Mannisto fails to expressly disclose the disabling of the telephone if the PIN is incorrectly entered a number of times.

In a similar field of endeavor, Harris et al discloses a system requiring entry of a code to change operating parameters (see column 1, lines 60-67), but when the code entry is not correct a conventional lockout routine is executed (see column 1, line 67 – column 2, line 6), which reads on the claimed "disabling the handset if the PIN number is incorrectly entered more than a predetermined number of times".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto to include the above disabling of the telephone if the PIN is entered incorrectly a number of times in order to enhance the security of the device by making it more difficult for an unauthorized user to break the code.

Regarding **claim 7**, the combination of Walter et al, Mannisto and Harris et al discloses between 3 and 5 tries as an exemplary number of incorrect entries (see Harris et al column 2, lines 2-6). The combination of Walter et al, Mannisto and Harris et al fails to expressly disclose 7 as the number of tries for entering a PIN however this difference is not critical to the invention and would not render the claimed invention patentable over the disclosed invention because both provide the end result of preventing an unauthorized user from the functions the PIN is protecting. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al, Mannisto and Harris et al such that the phone is disabled after 7 incorrect PIN entries in order to further prevent an unauthorized user from gaining access to the functions the PIN is protecting.

Regarding **claim 8**, the combination of Walter et al, Mannisto fails to expressly disclose that the predetermined number of times is 3.

In a similar field of endeavor, Harris et al discloses between 3 and 5 tries as an exemplary number of incorrect entries (see Harris et al column 2, lines 2-6).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Walter et al and Mannisto to include the above disabling of the telephone if the PIN is entered incorrectly a number of times in order to enhance the security of the device by making it more difficult for an unauthorized user to break the code.

Response to Arguments

Applicant's arguments filed March 23, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., while the call is in progress) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant argues the combination of Walter and Mannisto fails to disclose other call modes such as secure-only, clear and auto secure modes. The Examiner respectfully disagrees. Walter discloses both secure and insecure modes (see column 5, lines 14-48). Mannisto discloses an auto-locked state where only the unlock sequence will register in the phone once it is locked (see column 3, lines 35-45), together fulfilling the claimed limitations.

The Applicant argues the combination of Walter and Mannisto fails to disclose how a particular mode is activated based on how long a key is pressed and what mode the wireless handset is in. The Examiner respectfully disagrees. Mannisto is relied upon to teach these limitations. Specifically, Mannisto discloses a system where in order to set a keyboard lock, a user depresses and holds the key for a given delay period. If the button is not pressed for a certain amount of time, the phone does not enter the keyboard lock state (see column 2, line 62 – column 3, line 3). Further, if the

phone is in the auto-locked state, only the unlock sequence will register in the phone once it is locked (see column 3, lines 35-45).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is avoid the need for a separate key which takes up space in the keypad and increases manufacturing costs as suggested by Mannisto (see column 1, lines 60-61).

The Applicant makes similar arguments with respect to the remaining claims, however, for the same reasons outlined above, the Examiner respectfully disagrees.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bryan Fox
May 31, 2006

JEAN GELIN
PRIMARY EXAMINER